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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,426	11/24/2000	Christophe Lacroix	033808.136	1584

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EXAMINER

SHORT, PATRICIA A

ART UNIT PAPER NUMBER

1712

DATE MAILED: 05/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. <u>09/718426</u>	Applicant(s) <u>Lacroix et al</u>
Examiner <u>Short</u>	Group Art Unit <u>1712</u>

- The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address -

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- Responsive to communication(s) filed on April 9, 2002
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) 5, 7, 9, 10 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-4, 6, 8 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All  Some\*  None of the:
  - Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 6
- Notice of Reference(s) Cited, PTO-892
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Interview Summary, PTO-413
- Notice of Informal Patent Application, PTO-152
- Other \_\_\_\_\_

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Claims 7 and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Claims 5 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Applicant's election with traverse of Group I and ethylene alkyl (meth) acrylate unsaturated epoxide copolymer in Paper No. 9 is acknowledged. The traversal is on the ground(s) that as the search and examination of the claims overlap, there is no serious burden. This is not found persuasive because of reasons given in the restriction requirement. Different classification is prime facie evidence of a substantial burden. See MPEP 803. With respect to the election of species requirement, as stated in the requirement, upon the allowance of a generic claim, applicant will be entitled to consideration of additional species that are written in independent form or otherwise include all of the limitations of an allowed generic claim. Further, examination of the different inventions and species involves application of art that is relevant to one but not to the other which would be a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '680. The reference teaches polyester impact modified with a blend of ABS and an ethylene/glycidyl methacrylate copolymer. See page

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1, lines 22-46 and example I in Table A. Use of an ABS core shell copolymer is anticipated by or would have been obvious over the teachings of the reference.

Claims 1-4, 6 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '985. The reference teaches polybutylene terephthalate impact modified with a blend of ABS and an ethylene/glycidyl methacrylate copolymer. See page 1, lines 22-45 and examples I and II in Table 2. Use of an ABS core shell copolymer is anticipated by or would have been obvious over the teachings of the reference.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As the ranges for the impact modifier in parts (iii) and (iv) of claim 1 overlap, i.e. the range between 18 and 40 %, it is not clear which ratio of B/A applies when the amount of impact modifier is between 18 and 40 %. If both ratios apply for amount of impact modifiers between 18 and 40 %, then the ratio of A/B must be 25/75 as that is the only ratio that meets both ratio limitations. Further, in claim 1 the language "advantageously" is indefinite because it is not clear how it further limits the claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7 and 9 of copending Application No. 09/718,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application overlap with the claims of S.N. 09/718,427.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Laughner cited to show blends of polyester and polycarbonate with core-shell copolymer and ethylene/glycidyl methacrylate copolymer.

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